

Receipt #13

Dkt. 57453-C/JPW/FHB

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants : Beth Borowsky et al.  
U.S. Serial No.: 09/899,732  
Filing Date : July 5, 2001  
For : DNA ENCODING A HUMAN MELANIN CONCENTRATING  
HORMONE (MCH1) AND USES THEREOF

1185 Avenue of the Americas  
New York, New York 10036  
January 23, 2003

Assistant Commissioner for Patents  
Office of Initial Patent Examination  
Customer Service Center  
Washington, D.C. 20231

Sir:

SECOND COMMUNICATION TO CORRECT ERROR IN FILING RECEIPT

This Communication is filed in response to the January 9, 2003 Response to Request For Corrected Filing Receipt, a copy of which is attached hereto as **Exhibit A**, and to request the issuance of a corrected Filing Receipt in connection with the above-identified application. Specifically, the domestic priority data is incorrectly listed.

A corrected Filing Receipt should have nothing listed under Domestic Priority data.

The January 9, 2003 Response to Request For Corrected Filing Receipt indicates that to change to benefit claim of a U.S. prior filed application, applicants must amend specification with the desired change. Applicants contend that the specification was amended by the Amendment in Response to September 20, 2001 Notice to File Missing Parts of Nonprovisional Application - Filing Date

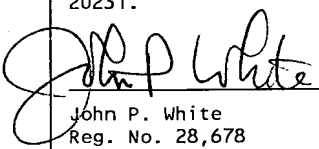
Applicants : Beth Borowsky et al.  
U.S. Serial No.: 09/899,732  
Filing Date : July 5, 2001  
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Granted, Petition to Amend Inventorship Under 37 C.F.R. §1.48(b), and Petition For a One-Month Extension of Time filed on December 20, 2001 in connection with the subject application. A copy of the Amendment is attached hereto as **Exhibit B**. Accordingly, applicants request that a corrected Filing Receipt be issued.

No fee is deemed necessary in connection with the filing of this Communication. However, if any fee is required, authorization is hereby given to charge the amount of any such fee to Deposit Account 03-3125.

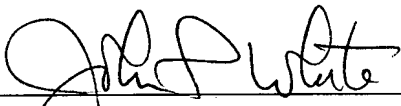
Respectfully submitted,

I hereby certify that this correspondence is being deposited this date with the U.S. Postal Service with sufficient postage as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Office of Initial Patent Examination Customer Service Center Washington, D.C. 20231.

  
John P. White  
Reg. No. 28,678

1/23/03

Date

  
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JPW



UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS  
UNITED STATES PATENT AND TRADEMARK OFFICE  
WASHINGTON, DC 20231  
www.uspto.gov

JAN 29 2003

APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATT Y. DOCK ET NO/TITLE
09/899,732	07/05/2001	Beth Borowsky	57453-C/JP W/ADM/PL

Cooper & Dunham LLP  
1185 Avenue of the Americas  
New York, NY 10036

JAN 14 2003  
AP

CONFIRMATION NO. 4135



\*OC000000009355836\*

Date Mailed: 01/09/2003

RESPONSE TO REQUEST FOR CORRECTED FILING RECEIPT

Domestic Continuity and Foreign Priority

In response to your request for a corrected Filing Receipt, the Office is unable to comply with the request because:

- ☐ The priority or continuity claim has not been entered because it was not filed during the required time period. Applicant may wish to consider filing a petition to accept an unintentionally delayed claim for priority. See 37 CFR 1.55 or 1.78.
- ☐ Continuity claimed under 35 U.S.C. § 120 cannot be added to the Filing Receipt without the applicant supplying the relationship (continuation, divisional, or continuation-in-part) in an Application Data Sheet or amendment to the first page of the specification.
- ☐ A claim for priority cannot be made based on an application filed after the application making the claim.
- ☐ Domestic benefit and foreign priority claims will not be captured in a provisional application. A provisional application is not entitled to a right of priority or to the benefit of an earlier filing date of any other application. See 35 U.S.C. § 111(b)(7) and 37 CFR 1.53(c)(4).
- ☐ A domestic continuity claim cannot be made to a foreign application and the filing receipt will only list the foreign country, application number, and filing date.
- ☐ Foreign priority will appear on the Filing Receipt in the following order:  
Country, Application number, Filing date.
- ☐ This application is the result of a conversion from a provisional application. Priority based on such application cannot be made since it no longer exists as a provisional application.
- ☐ The application(s) to which priority is claimed were filed over a year prior to the filing date of this application. Therefore, the referenced application(s) cannot be claimed as domestic or

foreign priority.

☒ To change the benefit claim of a U.S. prior-filed application, applicant must amend the first sentence of the specification (if the benefit claim is referenced in the specification), or provide a supplemental application data sheet (ADS) (if the benefit claim was submitted in an ADS), with the desired benefit claim. Note that once a benefit claim is deleted, applicant will not be able to claim such prior-filed application again, if the above-identified application was filed on or after November 29, 2000.

☐ To change a foreign priority claim, applicant must submit a supplemental oath or declaration (if the priority claim is referenced in the oath or declaration), or a supplemental application data sheet (ADS) (if the priority claim was submitted in an ADS), with the desired priority claim. If a supplemental ADS is submitted, any deletions should be shown with strikeouts. Note that once a priority claim is deleted, applicant will not be able to claim such foreign application again, if the above-identified application was filed on or after November 29, 2000.

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Office of Initial Patent Examination  
(703) 308-1202



Dkt. 57453-C/JPW/ADM/PL

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: : John A. Salon, et al  
U.S. Serial No. : 09/899,732  
Filed : July 5, 2001  
For : DNA ENCODING A HUMAN MELANIN  
CONCENTRATING HORMONE RECEPTOR (MCH1)  
AND USES THEREOF

1185 Ave of the Americas  
New York, New York 10036  
December 20, 2001

Assistant Commissioner for Patents  
Washington, D.C. 20231  
ATTN: Box Missing Parts

Sir:

AMENDMENT IN RESPONSE TO SEPTEMBER 20, 2001 NOTICE TO FILE  
MISSING PARTS OF NONPROVISIONAL APPLICATION - FILING DATE  
GRANTED, PETITION TO AMEND INVENTORSHIP UNDER 37 C.F.R.  
§1.48(b), AND PETITION FOR A ONE-MONTH EXTENSION OF TIME

This Amendment is submitted in response to the September 20, 2001 Notice To File Missing Parts of Application - Filing Date Granted issued by the United States Patent and Trademark Office in connection with the above-identified application. A response to this September 20, 2001 Notice was due November 20, 2001. Applicants hereby petition for a one-month extension of time in which to respond to the September 20, 2001 Notice. The fee for a one-month extension of time for a small entity is FIFTY-FIVE DOLLARS (\$55.00) and a check including this amount is enclosed. With a one-month extension of time, a response is now due December 20, 2001. Accordingly, this Amendment is being timely filed.

Please amend the subject application as follows:

In the Specification:

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Please delete the paragraph on page 1, lines 6-12.

In the Claims:

Please cancel claims 42 and 122-124 without disclaimer or prejudice to applicants' right to pursue the subject matter of these claims in a future continuation or divisional application.

Please amend claim 198 as follows:

- 198. (Amended) A method of treating depression in a subject which comprises administering to the subject a composition comprising a pharmaceutically acceptable carrier and a therapeutically effective amount of a MCH1 antagonist, wherein:
- (a) (1) the MCH1 antagonist does not inhibit the activity of central monoamine oxidase A greater than 50 percent, at a concentration of 10mM; and  
(2) the MCH1 antagonist does not inhibit the activity of central monoamine oxidase B greater than 50 percent, at a concentration of 10mM; and
  - (b) the MCH1 antagonist binds to the MCH1 receptor with a binding affinity at least ten-fold higher than the binding affinity with which it binds to each of the following transporters: serotonin transporter, norepinephrine transporter, and dopamine transporter.--

Please add new claims 208-213 as follows:

- 208. (New) A method of treating anxiety in a subject which comprises administering to the subject a composition

comprising a pharmaceutically acceptable carrier and a therapeutically effective amount of a MCH1 antagonist, wherein the MCH1 antagonist binds to the MCH1 receptor with a binding affinity at least ten-fold higher than the binding affinity with which it binds to each of the following transporters: serotonin transporter, norepinephrine transporter, and dopamine transporter.--

--209. (New) The method of claim 208, wherein the MCH1 antagonist also binds to the MCH1 receptor with a binding affinity at least ten-fold higher than the binding affinity with which it binds to each of the human 5HT<sub>1A</sub>, human 5HT<sub>1B</sub>, human 5HT<sub>1D</sub>, human 5HT<sub>1E</sub>, human 5HT<sub>1F</sub>, human 5HT<sub>2A</sub>, rat 5HT<sub>2C</sub>, human 5HT<sub>4</sub>, human 5HT<sub>6</sub> and human 5HT<sub>7</sub> receptors.--

--210. (New) The method of claim 208, wherein the MCH1 antagonist also binds to the MCH1 receptor with a binding affinity at least ten-fold higher than the ~~binding affinity with which it binds to the human~~ histamine H<sub>1</sub> and H<sub>2</sub> receptors.--

--211. (New) The method of claim 208, wherein the MCH1 antagonist also binds to the MCH1 receptor with a binding affinity at least ten-fold higher than the binding affinity with which it binds to the human dopamine D<sub>1</sub>, D<sub>2</sub>, D<sub>3</sub>, D<sub>4</sub> and D<sub>5</sub> receptors.--

--212. (New) The method of claim 208, wherein the MCH1 antagonist also binds to the MCH1 receptor with a binding affinity at least ten-fold higher than the binding affinity with which it binds to the human  $\alpha_{1A}$

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adrenoceptor, the human  $\alpha_{1B}$  adrenoceptor and the human  $\alpha_{1D}$  adrenoceptor.--

--213. (New) The method of claim 208, wherein the MCH1 antagonist also binds to the MCH1 receptor with a binding affinity at least ten-fold higher than the binding affinity with which it binds to the human  $\alpha_{2A}$  adrenoceptor, the human  $\alpha_{2B}$  adrenoceptor and the human  $\alpha_{2C}$  adrenoceptor.--

A marked-up copy of the amendments showing the changes made is attached herewith as **Exhibit 3**.

**In the Inventors:**

Please delete John A. Salon, Thomas M. Laz, Raisa Nagorny, and Amy E. Wilson as inventors.

**REMARKS**

Claims 42, 122-124, and 198-207 were pending in the subject application. By this Amendment, applicants have canceled claims 42 and 122-124 without prejudice or disclaimer, amended claims 198-207, and added new claims 208-213. Accordingly, upon entry of this Amendment, claims 198-213 will be pending and under examination.

Applicants have amended page 1 of the specification to remove any priority claim for the subject application.

Applicants maintain that new claims 208-213 and the amendment to claim 198 raise no issue of new matter. Support for amended claim 198 and for new claim 208 may be found inter alia in the



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specification, as originally-filed, on page 93, lines 1-17. Support for new claim 209 may be found inter alia in the specification, as originally-filed, on page 93, lines 23-28. Support for new claim 210 may be found inter alia in the specification, as originally-filed, on page 93, lines 30-33. Support for new claim 211 may be found inter alia in the specification, as originally-filed, on page 93, line 35 through page 94, line 4. Support for new claim 212 may be found inter alia in the specification, as originally-filed, on page 94, lines 6-10. Support for new claim 213 may be found inter alia in the specification, as originally-filed, on page 94, lines 12-16.

Accordingly, applicants respectfully request that the amendment be entered.

**Declaration and Power of Attorney**

The Notice To File Missing Parts Of Nonprovisional Application indicates that the oath or declaration is missing. Applicants attach hereto a copy of the Notice as **Exhibit 1**. In response, applicants submit as **Exhibit 2** hereto a Declaration and Power of Attorney pursuant to 37 C.F.R. §1.53(f). In compliance with 37 C.F.R. §1.63, the Declaration refers to the application's above-identified serial number and filing date.

The late Declaration surcharge set forth in 37 C.F.R. §1.16(e) for a small entity is SIXTY-FIVE DOLLARS (\$65.00) and a check including this amount is enclosed.

**Petition To Amend Inventorship Under 37 C.F.R. §1.48(b)**

Due to the cancellation of claims 42 and 122-124 hereinabove, applicants have deleted John A. Salon, Thomas M. Laz, Raisa

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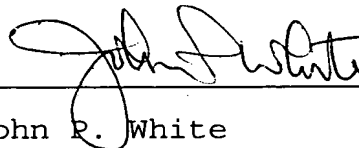
Nagorny, and Amy E. Wilson as inventors. Beth Borowsky, Thomas P. Blackburn, and Kristine Ogozalek are the inventors of the subject matter claimed in pending claims 198-213.

Pursuant to §1.48(b)(2), the ONE HUNDRED THIRTY DOLLAR (\$130.00) processing fee set in §1.17(i) is required to amend inventorship under §1.48(b), and a check including this amount is enclosed.

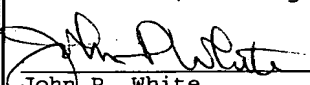
If a telephone interview would be of assistance in advancing prosecution of the subject application, applicants' undersigned attorney invites the Examiner to telephone him at the number provided below.

No fee, other than the enclosed \$250.00 fee (\$55.00 for a one-month extension of time, \$65.00 late Declaration surcharge, and \$130.00 processing fee for amending inventorship), is deemed necessary in connection with the filing of this Amendment. However, if any other fee is required, authorization is hereby given to charge the amount of any such fee to Deposit Account No. 03-3125.

Respectfully submitted,



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I hereby certify that this correspondence is being deposited this date with the U.S. Postal Service with sufficient postage as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, DC 20231	
 John P. White Reg. No. 28,678	12/20/01 Date